

REMARKS/ARGUMENTS

This Amendment responds to the Office Action dated May 11, 2011 in which the Examiner rejected claims 1-2, 4-6 and 8-11 under 35 U.S.C. § 103.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 1-2 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Ellis, et al.* (U.S. Publication No. 2003/0149988).

Kuroda appears to disclose a storage device 105 stores content signals according to a viewer's direction. The storage device 105 may comprise a plurality of storage device with a removable medium. The storage device 105 may be built-in the video recorder/player or connected with the video recorder/player as a peripheral device (column 4, lines 38-44). In reference with Figure 3, a description will be made about a recording action of the video recorder/player (column 5, lines 9-11). If the remaining capacity is insufficient at Step 107, Step 111 is executed. A dialog of Figure 6 warns that the storage device selected at Step 106 does not have sufficient capacity for recording the contents and allows the viewer a choice to select another storage device or to record the storage device at Step 106 (Step 111). If another storage device is selected, then Step 112 follows Step 111 or else Step 108 follows Step 111 (column 5, lines 60-67).

Thus, *Kuroda* only discloses if insufficient capacity remains, warning the user by displaying a dialogue box. Nothing in *Kuroda* shows, teaches or suggests a controller which automatically issues a recording substitution request only in response to the determination of a failure without input from a user as claimed in claim 1. Rather, *Kuroda* teaches away from the

claimed invention since a dialog box is displayed to a user so that the user can select another storage device.

Ellis, et al. appears to disclose a remote media server 24 records programs and program guide data on storage 15 in response to record requests generated by the program guide implemented on the interactive program guide television equipment 17 [0084]. The record requests generated by program guides implemented on interactive program guide television equipment 17 may be queued in request queue 110 for consolidation [0085]. The communication paths 20 may be any communication paths suitable for distributing program guide data [0065]. If the program guide is implemented on user television equipment 22 of interactive program guide television equipment 17 as shown in Figure 2c, internet service system 61 may provide program guide data to user television equipment 22 via the internet or via program guide distribution equipment 21. If the program guide implemented on interactive program guide television equipment 17 is a client-server guide as shown in Figure 2d, program guide server 25 may obtain program guide data from internet service system 61 [0070]. An online program guide can be implemented using a personal computer 231 as shown in Fig. 2e [0072]. Programs and program guide data may be recorded and played back on demand by remote media server 24 in response to record and playback requests generated by a program guide server application or web application [0074]. Figure 2c and 2d show internet based interactive television program guide systems [0069].

Thus, *Ellis, et al.* merely discloses recording and play back of programs and program guide data in response to record and play back requests generated by a guide server application or web application. Nothing in *Ellis, et al.* shows, teaches or suggests a controller automatically issuing a recording substitution request only in response to the determination of a failure without

input from a user as claimed in claim 1. Rather, *Ellis, et al.* only discloses recording and play back programs and program guide data in response to record and play back request generated by a guide server application or web application.

A combination of *Kuroda* and *Ellis, et al.* would merely suggest that when remaining capacity is insufficient, asking a user to choose another storage device as taught by *Kuroda* while having the program and program guide data recorded and played back in response to a program guide server application or web application. Thus, nothing in the combination of the references shows, teaches or suggests a controller automatically issuing a recording substitution request only in response to the determination of a failure without input from a user as claimed in claim 1. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 1 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicants respectfully submit that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Ellis, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

As discussed above, *Kuroda* merely discloses if insufficient capacity is determined, allowing a viewer to select another storage device. Thus, nothing in *Kuroda* shows, teaches or suggests a recording substitution means responding to reception of a recording substitution request from a recording device which has experienced a failure within the recording device as claimed in claims 4 and 9. Rather, *Kuroda* only discloses allowing a viewer to choose another storage device when insufficient capacity is determined.

As discussed above, *Ellis, et al.* only discloses recording and play back of programs and program guide data in response to record and play back request generated by a program guide server application or web application. Nothing in *Ellis, et al.* shows, teaches or suggests a recording substitution means responding to reception of a recording substitution request from a recording device which has experienced a failure within the recording device as claimed in claims 4 and 9. Rather, *Ellis, et al.* only discloses recording and play back of program and program guide data in response to record and play back requests generated by a program guide server application or web application.

Zigmond, et al. appears to disclose methods and systems for selecting and inserting advertisements into a video programming feed at the household level (column 1, lines 10-12). Viewer response information is collected in a statistics collection location 61 which may be located at the home entertainment system or at a remote site (column 9, lines 39-55).

Thus, *Zigmond, et al.* only discloses collecting statistics. Nothing in *Zigmond, et al.* shows, teaches or suggests a recording substitution means/portion which responds to reception of a recording substitution request from an external recording device which has experienced a failure within the recording device as claimed in claims 4 and 9. Rather, *Zigmond, et al.* only discloses collecting viewer response information.

A combination of *Kuroda, Ellis, et al.* and *Zigmond, et al.* would merely suggest to allow a user to select another storage device when insufficient capacity remains as taught by *Kuroda*, to record and play back program and program guide data in response to record and play back request generated by a program guide server application or web application as taught by *Ellis, et al.* and to collect viewer response information as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests a recording substitution means/portion

which responds to reception of a recording substitution request from an external recording device which has experienced a failure within the recording device as claimed in claims 4 and 9.

Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda*, *Ellis*, *et al.* and *Zigmond*, *et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 5-6 under 35 U.S.C. § 103.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler*, *et al.* (U.S. Patent No. 5,805,763) and *Ellis*, *et al.*

Kuroda appears to disclose if a viewer directs to record a program before the program is deleted from the temporary storage device 103, the program is moved to a storage device 103 not to be deleted automatically (column 12, lines 20-23).

Thus, *Kuroda* only discloses moving a program. Nothing in *Kuroda* shows, teaches or suggests a controller automatically issuing a recording substitution request only when a failure is determined as claimed in claim 8. Rather, *Kuroda* only discloses moving a program when a viewer directs to record a program before deletion.

Lawler, *et al.* appears to disclose a system 10 has a central head end 12 that supplies programming over a network 14 to multiple viewer stations 16 that are typically located in the homes of system users or subscribers (column 3, lines 29-34). Network 14 carries bidirectional communication between the viewer stations 16 and the head end 12 (column 5, lines 28-31). A user can set a record tag by activating a record button 130 (column 12, lines 29-31). The record

tag can be thought of as a request to the system to record a program. Each record tag is associated with a program to be recorded and to view station or user that set the record tag (column 12, lines 56-61). When the record tag is set, it is stored at the head end 12 in servers 30 or 26 (column 13, lines 8-12). The head end monitors the record tags of all system users and if any user has set a record tag, the head end controls the recording device to record the program. The recorded program is stored at the head end 12 or servers 32 (column 13, lines 26-37).

Thus, *Lawler, et al.* merely discloses a user setting a record tag to record a program and having a head end monitor the record tags to record a program. Thus, nothing in *Lawler, et al.* shows, teaches or suggests a controller portion automatically issuing a record substitution request only when a failure is determined as claimed in claim 8. Rather, *Lawler, et al.* only discloses recording a program when a viewer sets a record tag.

As discussed above, *Ellis, et al.* merely discloses recording and play back of programs and program guide data in response to record and play back request generated by a program guide server application or web application. Nothing in *Ellis, et al.* shows, teaches or suggests a controller portion automatically issuing a recording substitution request only when a failure is determined as claimed in claim 8. Rather, *Ellis, et al.* only discloses recording and play back in response to record and play back requests generated by a program guide server application or web application.

The combination of *Kuroda, Lawler, et al.* and *Ellis, et al.* would merely suggest that if a viewer directs to record a program before a program is deleted from the temporary storage, the program is moved to another storage device not to be automatically deleted as taught by *Kuroda*, to have a viewer set a record tag which is monitored to control recording of a program as taught by *Lawler, et al.* and to record and play back programs and program guide data in response to

record and play back requests generated by a program guide server application or web application as taught by *Ellis, et al.* Thus, nothing in the combination of the references shows, teaches or suggests a controller portion automatically issuing a recording substitution request only when a failure is determined as claimed in claim 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and further in view of *Zigmond, et al.* Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* and *Ellis, et al.* and further in view of *Zigmond, et al.*

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the combination of the references shows, teaches or suggests the primary features as claimed in claims 1, 4 and 8-9, Applicants respectfully submit that the combination will not overcome the deficiencies of the independent claims. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested. Should the Examiner find that the application is not now in condition for allowance, Applicants respectfully request the Examiner enters this Amendment for purposes of appeal.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

Date: July 6, 2011

By: 

Ellen Marcie Emas
Reg. No. 32,131
Tel. (202) 292-1530